



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,458	12/03/2003	Masaru Kohno	0229-0782P	4040

2292 7590 01/25/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,458

Applicant(s)

KOHNO, MASARU

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 17 is/are rejected.
- 7) ☒ Claim(s) 9-16 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The changes to the specification are agreed with and the objection to under 37 C.F.R. rule 1.71 is removed.

Claim Rejections - 35 USC § 112

2. The changes to the specification are agreed with and the rejections under 35 U.S.C. 112, first paragraph, are removed.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 and 4 are indefinite in that the lower limit of the moment of inertial is broader than the lower limit of the claim they depend on in claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2000-210398 in view of Stites.

2000-210398 discloses a wood type head (Fig. 1) having a moment of inertia (M) around a center line of a shaft axis being 6000 gxc^2 (Table at top of page 3, verbal translation) which meets the conditions of ($5950 \text{ gxc}^2 \leq M \leq 7000 \text{ gxc}^2$) and a depth L of center of gravity being 35 mm or greater ([0018], Verbal translation) which meets the condition of being $30 \text{ mm} \leq L \leq 50 \text{ mm}$ (1.18 –19.7 inches).

2000-210398 does not disclose the conditions of the moment of inertial (M) with respect to the depth of the center of gravity (L) as stated in claims 1-8.

Stites discloses a depth L of center of gravity being $30 \text{ mm} \leq L \leq 50 \text{ mm}$ (1.18 –19.7 inches) in the form of a lateral distance from a lower edge of a face to a center of gravity (CGx) being (Col. 5, Lns. 50-51) between 1.5 to 2.65 inches (38.1mm to 67 mm) (Col. 6, Lns. 39-40) in order to position the center of gravity further from a face and heel to assist the golfer in closing the face angle at moment of impact, which will tend to produce shots which travel in a straight distance down the fairway (Col. 5, Lns. 60-64). In view of the patent of Stites it would have been obvious to modify the head of 2000-

Art Unit: 3711

210398 to have the depth of the center of gravity (L) being 50 mm in order to position the center of gravity further from a face and heel to assist the golfer in closing the face angle at moment of impact, which will tend to produce shots which travel in a straight distance down the fairway. As such the conditions of the moment of inertial (M) around a center line of a shaft axis being 6000 gxc^2 and a depth L center of gravity being 50 mm would meet the relationships of M and L in claims 1-8 and 17.

Allowable Subject Matter

7. Claims 9-16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claims 9-16, none of the prior art discloses or renders as obvious a weight member being mounted in a concave portion formed on a sole at the location claimed with moment of inertia and depth of center of gravity meeting the conditions in claim 1 in addition to the other elements of structure claimed. With respect to claim 18, none of the prior art discloses or renders as obvious a weight member being mounted in a concave portion formed on a sole with a tapered portion extending from a columnar body to an outer surface of a sole portion, a tapered portion covered by a concave portion so the columnar body is fixed in the concave portion with a moment of inertia and depth of center of gravity meeting the conditions in claim 1 in addition to the other elements of structure claimed.

Response to Arguments

8. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 20 January 2006


STEPHEN BLAU
PRIMARY EXAMINER